10-18-04

AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	Examiner: GARG, YOGESH C
BAUM	Art Unit: 3625
Application No.: 10/038,004	
Filed: 1/2/2002	**APPELLANT'S BRIEF UNDER**
For: DISTRIBUTING IMAGES TO MULTIPLE RECIPIENTS	**37 C.F.R. §1.192**

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Sirs:

Appellant offers this Appeal Brief in furtherance of the Notice of Appeal filed on August 31, 2004 in the above-referenced patent application. Please deduct any requisite small entity fee, pursuant to 37 C.F.R. § 1.17(c), from deposit account 501861, and deduct any additional fees or credit any excess fees associated with the Appeal Brief to such deposit account. Appendix A, attached hereto, contains a copy of all claims pending in this case.

REAL PARTY IN INTEREST

All right, title, and interest in the subject invention and application are assigned to Shutterfly, Inc., having offices at 2800 Bridge Parkway, Suite 101, Redwood City, CA 94065. Therefore, Shutterfly, Inc. is the real party interest.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1-21 are present in the application. Claims 1, 14, 16, 17 and 21 were amended in an RCE preliminary amendment in response to Comments made in the Examiner's Answer mailed 8/26/03 for the First Appeal Brief filed on July 1, 2003. Claims 1-21 have been rejected and are the subjects of this appeal. No other claims are pending.

STATUS OF AMENDMENTS

A Final Office Action was mailed on 6/17/04. No amendment has been filed in response to the Final Office Action. An After Final Response was submitted on 7/13/04. An Advisory Action was mailed 8/10/04 noting that the Terminal Disclaimer was not acceptable. A substitute Terminal Disclaimer and Notice of Appeal were filed on 8/31/04. A copy of all the pending claims is provided in Appendix A, attached hereto.

SUMMARY OF THE INVENTION

The present invention is related generally to distributing images, for example, digital and/or physical copies of images, to multiple recipients.

In accordance one aspect of the invention, one way to place an order is by having the user view previously uploaded images online, for example, with a browser and selectively designate which images should be printed. The user also will specify one or more recipients to whom prints should be distributed and, further, print parameters for each of the individual recipients, for example, not only parameters such as the size, number of copies and print finish, but potentially also custom messages to be printed on

the back or front of a print. Application at page 19, lines 3-10. After the recipients and respective parameters have been specified, the user's order is fulfilled by making prints of the designated images and distributing them to the specified recipients (step 406). Application at page 19, lines 15-18.

Fig. 5 shows an exemplary graphical user interface (GUI) based environment that employs iconographic aliases (graphical representations of distribution groups) and graphical input techniques to enable a user to designate intended recipients of digital images and/or prints of the digital images. In the example shown in Fig. 5, the user, Jane Smith, has accessed her most recently uploaded images by entering into the browser's Address field 520 a uniform resource locator (URL) address 521 provided to her by the photo-finisher and corresponding to a web page at which her most recent images are hosted. In response, the browser window 501 accesses the specified address and displays its contents, namely, a greeting message 522, twelve images 508-519 recently uploaded by Jane, a link 523 to an archive that includes all of Jane's uploaded images, photo albums 524-526 representing collections of related images as grouped by Jane, and a picture delivery bar 500. Application, page 20, lines 5-15.

The picture delivery bar 500 includes one or more iconographic distribution aliases 502-507, each of which represents a distribution group of one or more recipients. The recipients specified in a distribution group may or may not have overlapping members in common with other distribution groups. For example, a member of the user's Friends distribution alias 504 may include one or more recipients who also are members of that user's Basketball Team distribution alias 506 or Co-workers distribution alias 505. In general, no limitations exist on the number or identities of members in a particular distribution alias. Application, page 20, lines 16-23.

As shown above, ease of use is provided to the user who orders a plurality of cards for different recipients. The cards may or may not be customized (for example, customized border or customized cropping, among others). This capability is useful during the winter holiday season, for example, to allow users to order 50 to 100 Christmas cards online for their family members and friends, who may be residing at different locations. Running through an order process one at a time for each of the 50-100

Christmas cards is time consuming. This inconvenience in prior art ordering systems would deter many users from using the customized features for online card ordering.

ISSUES

I. Whether claims 1-3, 5-12, and 14-21 are unpatentable over Shiota (USPN 6,324,521), Lockhart (Application Serial No. 2002/0103697), Johnson (USPN 6,052,670) and Hartman (USPN 5,960,411) under 35 U.S.C. § 103(a).

II. Whether claim 4 is unpatentable over Shiota/Lockhart/Johnson/Hartman and Tackbary et al. (USPN 6,092,054) under 35 U.S.C. § 103(a).

III. Whether claim 13 is unpatentable over Shiota/Lockhart/Johnson/Hartman and Official Notice under 35 U.S.C. § 103(a).

GROUPING OF THE CLAIMS

For each ground of rejection that appellant contest herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

ARGUMENT

I. CLAIMS 1-3, 5-12, AND 14-21 ARE PATENTABLE OVER SHIOTA/LOCKHART/JOHNSON/HARTMAN

Claims 1-3, 5-12 and 14-21 were rejected under Section 103(a) as unpatentable over Shiota in view of Lockhart, Johnson and Hartman. Shiota relates to a network photograph service system with at least one laboratory server which has communication ability via a network and is installed in a laboratory having a picture printer, and a center server installed in a service center which receives a printing service order via the network. The center server carries out processing including the steps of storing a picture recorded by a customer of each laboratory as digital image data, making the digital image data accessible on the network, selecting one laboratory to output a print among the laboratories in response to order information transferred from the customer via the

network, and providing a printing service requested by the order to the customer by transmitting instructing information to the laboratory server installed in the selected laboratory.

The Office Action acknowledged that Shiota does not expressly disclose that the images are directly loaded by a user when generating the card, but noted that

> However, in the field of same endeavor, that is generating a postcard online including image and text to be delivered to recipients, Lockhart discloses uploading of images directly by a user to be included in the said postcard and page 4 paragraph 062, " ... the user is allowed to upload an image using a web interface (e.g., region 302 of the exemplary web page shown in Fig. 3). That is, the user clicks on a "Browse" button 306 to select a graphical image (e.g., a JPG image) that resides on the user system hard drive or network neighborhood. The user then initiates uploading the image (button 308), and the image data is transferred to mail service computer 110. Such methods for uploading files are known in the art.
>
> In view of Lockhart, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota to incorporate the Lockhart's teachings of uploading images directly by the user because when the desired images are not already available at the image server 15 in Shiota, it will allow the users to upload images directly from another source as explicitly suggested in Lockhart (see at least page 4, paragraphs 0050-0053, " ..Where appropriate (i.e., when the image does not already reside on the mail service computer) the selected image is transferred to mail service computer in step 208 and suitably displayed to the user, e.g., by launching a web browser
>
> In general, in the case where the user wishes to create a post card incorporating one or more graphics based on an online...,a postcard showcase, or a photo collection, the appropriate graphical elements are stored at any convenient site accessible to the user over network 106. For example, the images may be located in a database 111 or other storage medium associated with mail service computer 110..."

The Final Office Action further noted on pages 3-4 that Lockhart is relevant to show "uploading of images directly by a user to be included in the said postcard... The examiner could rely on these teachings of Lockhart for generation of a desired postcard in Shiota for the same objective of allowing the user to use photographs of his choice in the postcard and transfer those photographs directly from any accessible site to the user to the WWW application server 36. "

While Applicants agree that Lockhart shows uploading of images, Lockhart also points away from the claimed element of "receiving a single card order specifying a

plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence."

Lockhart relates to a method for generating and distributing mail items that includes creating a first and a second mail file, wherein each of the first and second mail files includes recipient address information, and wherein the first mail file is generated by a first user, and the second mail file is generated by a second user. The first and second mail files are then transmitted to a mail service computer over a global computer network and printed, on a single sheet of media, a first mail item in accordance with the first mail file, and a second mail item in accordance with the second mail file. The first and second mail items are then placed into a surface mail system. The first mail item is addressed in accordance with the first recipient address information, and the second mail item is addressed in accordance with the second recipient address information. The mail item is then placed into the surface mail system in such a way as to minimize handling damage, and to leverage available postal technology. The mail items are then delivered to the postal addresses of the intended recipients.

Here, Lockhart shows two separate "orders" by first and second users that are then merged into a package for mailing. Lockhart does not receive a single card order specifying recipients that is completed in a single transaction sequence. Thus, Lockhart points in the opposite direction to the claimed element of "receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence". Hence, the combination is improper as Lockhart teaches away from the invention.

Further, the Office Action acknowledged that

> Shiota in view of Lockhart as applied to claim 1 does not expressly disclose receiving a single order for the plurality of recipients. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Johnson discloses receiving a single order for the plurality of recipients (see at least FIG.16 and col.22, lines 6062, " Customer has a "contains by value" relationship with the Order class. In other words, each customer may have one or more orders, and each order may have multiple ship addresses and multiple order items ". Note: each order having multiple ship addresses corresponds to receiving order for plurality of recipients in a single

transaction). In view of Johnson, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota in view of Lockhart as applied to claim 1 to incorporate the Johnson's teachings of receiving a single order for a plurality of recipients because it will reduce the number of purchaser interactions needed to place orders for different recipients and thereby making it convenient and faster for the user to have the system receive one order for all the recipients.

The Final Office Action stated on pages 4-5 that prima facie case of obviousness has been established because "it will reduce the number of purchaser interactions needed to place orders for different recipients and thereby making it convenient and faster for the user to have the system receive one order for all the recipients... In this case, the combined teachings of Shiota in view of Lockhart when combined with Johnson, as per the knowledge generally available to one of ordinary skill in the art will reduce the number of purchaser interactions needed to place orders for different recipients and thereby making it convenient and faster for the user to have the system receive one order for all the recipients."

Applicants again traverse the rejection. Johnson relates to an object oriented framework mechanism that provides a straightforward and convenient way to implement an electronic catalog by providing an infrastructure that embodies the steps necessary for a framework consumer to define an electronic catalog by extending the framework to fit a particular electronic catalog environment.

The combination of Johnson is improper since Johnson's catalog system is not required in a system that receives "a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence." The cards in the card orders are created by the user using image data uploaded by the user. The electronic catalog system in Johnson would fail to combine with Shiota/Lockhart to produce the present invention system because the electronic catalog only provide users with off-the-shelf standardized products and is not capable of receiving image data for a user to create a card for a card order.

Additionally, the combination would be inoperative or unnecessary because the customer has the data for the item and is simply placing a single card order specifying a

plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. One skilled in the art would not look to Lockhart or Johnson since catalogs are more appropriate with off-the-shelf standardized products not produced by the customer.

Moreover, the combination still does not show receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. The Office Action acknowledged that

> Shiota in view of Lockhart further in view of Johnson as applied to claim 1 does not expressly suggest receiving order in a single transaction sequence. However, in the field of same endeavor of conducting electronic commerce and the analogous art of placing orders online, Hartman discloses receiving an order in a single transaction sequence (see at least col.2, lines 50-57, " An embodiment of the present invention provides a method and system for ordering an item from a client system. The client s ystem displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item..."). In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Shiota in view of Lockhart and further in view of Johnson as applied to claim 1 to incorporate the Hartman's teachings of receiving an order in a single transaction sequence because the single transaction sequence ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37).

Hartman relates to a method and system for placing an order to purchase an item via the Internet. The order is placed by a purchaser at a client system and received by a server system. The server system receives purchaser information including identification of the purchaser, payment information, and shipment information from the client system. The server system then assigns a client identifier to the client system and associates the assigned client identifier with the received purchaser information. The server system sends to the client system the assigned client identifier and an HTML document identifying the item and including an order button. The client system receives and stores the assigned client identifier and receives and displays the HTML document. In response to the selection of the order button, the client system sends to the server system a request

to purchase the identified item. The server system receives the request and combines the purchaser information associated with the client identifier of the client system to generate an order to purchase the item in accordance with the billing and shipment information whereby the purchaser effects the ordering of the product by selection of the order button.

The Office Action asserted that Hartman's sentence "The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item..."') corresponds to the claimed receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence.

Applicants respectfully traverse the assertion that Hartman shows the claimed receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. At best, Hartman shows clicking a mouse button to order the identified item. This is not the same as receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. Hence, Hartman fails to show the claimed element.

Additionally, the combination of Shiota/Lockhart/Johnson/Hartman is improper because Lockhart and Johnson teach away from the claimed receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence, as discussed above. Even though Hartman shows a single action such as clicking a mouse button that a purchaser is to perform to order the identified item, there is no suggestion in Shiota, Lockhart, Johnson or Hartman to form system that receives "a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence." There is no suggestion to combine, and the rejection is

simply using hindsight taught by the instant invention to combine the references in the specific manner of claim 1.

Further, Shiota/Lockhart/Johnson/Hartman does not show that a user directly upload images. Hence, the references do not have the **user-uploaded** aspect as claimed. To compare, Claim 1 recites:

> receiving **a single card order specifying a plurality of recipients** and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence;
>
> for each of the plurality of recipients specified in the received card order, printing at least one card having at least one **user-uploaded** image from the recipient's image set; and
>
> distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.

Hence, the user-uploaded element is missing in Shiota/Lockhart/Johnson/ Hartman, and this is another basis for traversing the Section 103 Rejections.

Since at least two elements are missing in the references, the independent claims and those dependent therefrom are patentable over Shiota/Lockhart/Johnson/Hartman. Hence, the references cannot render dependent claim 3 obvious. Additionally, claim 4 is patentable since Shiota/Lockhart/Johnson/Hartman do not show the specifics of print parameters that include one or more of print size, number of copies, print finish, and/or a textual message for the printed cards. With regard to claims 5-6, the references show that a print service uploads images scanned from film. However, there is no teaching that a user directly uploads the images. Claims 7-8 are allowable in that they depend from allowable claim 1. With respect to claim 9, the references do not show single order/multiple recipient with a web front-end for a user to upload images and thus claim 9 is allowable over the references. With regards to claims 11-12, none of the references show that the card order comprises a single transaction sequence or a single transaction sequence terminated by a click of a "card order" button (see discussion of single order with multiple recipients above).

With respect to claim 14, none of the references show a front-end computer sub-system for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient, such images being directly uploaded by a user to the front-end computer sub-system, wherein the single card order is completed in a single transaction sequence. Hence, claim 14 is patentable over the combination.

With respect to Claim16, the references do not show a computer-implemented method of ordering cards for a plurality of recipients by receiving at a host system a single card order from a client system, the card order corresponding to a single transaction sequence and specifying a plurality of recipients and, associated with each specified recipient, a set of one or more images directly uploaded by a user, wherein the single card order is completed in a single transaction sequence. Withdrawal of the rejection on claim 16 is requested

With respect to Claim 21, Shiota does not show at least receiving a card order from an orderer, such order specifying a plurality of recipients where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient. Withdrawal of the rejection on claim 21 is requested.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Shiota reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's

disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

First, Applicant notes that the references fail to teach or suggest all the claim limitations of the independent claims. In particular, independent claim 1 recites receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence; for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients. The receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence is not reasonably taught or suggested in the cited art reference.

Secondly, Applicant notes that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Shiota reference so as to produce the claimed invention. Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in the references, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of the independent claims. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the references, or knowledge of those skilled in the art, for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence, *prima facie* obviousness of the independent claims and those dependent therefrom has not been established. As such, it is respectfully requested that the § 103(a) rejections be withdrawn and the claims be allowed.

II. CLAIM 4 IS PATENTABLE UNDER SECTION 103(A) OVER SHIOTA/ LOCKHART/ JOHNSON/HARTMAN AND TACKBARY (USPN 6,092,054).

Claim 4 was rejected under Section 103(a) as unpatentable over Shiota/Lockhart/Johnson/Hartman and Tackbary (USPN 6,092,054). Tackbary relates to a card distribution center for selecting, ordering, and sending social expression cards using a personal computer. The user can enter names and addresses of card recipients into the system wherein the information is maintained in a database. The system displays digitized images of the cards on a display screen which are retrieved from a card database. From the cards displayed, the user can select cards for designated recipients and enter personalized messages and a digitized signature. The user may then send the order to a card distribution center, which processes the order, retrieves and prints the selected card images, including any user messages or user signature, and mails the cards to designated recipients or customers.

Tackbary relies on pre-designed cards that are digitized and stored in a database that the user can't upload as follows:

> It is also known that card buyers can design their own cards on personal computers. However, many individuals do not wish to spend time designing cards. Moreover, the card quality is limited by user constraints such as the quality of the user's printer, quality of the available graphics and papers, and the design ability and creativity of the user.
>
> Thus, social expression card buyers need a method of card purchasing which does not inconvenience them with its method of selecting and sending the cards. In addition, it would be advantageous to have a method that provides a

wide selection of cards which also automatically maintains recipient and purchase information about the buyer's card purchases, card recipients and associated dates.

In the instant invention, the user-uploaded image (or picture) **is** the card design. Hence, Tackbary **teaches away from the invention** in that it requires the user to select from a database of predesigned cards rather than upload his or her own image. For this reason, Appellant notes that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Shiota et al. reference so as to produce the claimed invention.

Moreover, Appellant notes that neither Shiota et al. nor Tackbary teaches or suggests all the claim limitations of claim 4. In particular, the "receiving a singlecard order specifying a plurality of recipients and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient" and "for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set" are not reasonably taught or suggested in the cited art reference, as discussed above.

Moreover, Appellant notes that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Shiota et al. reference so as to produce the claimed invention. Further, Appellants fail to identify any motivation to modify the reference teaching so that for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set as presently claimed.

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Shiota et al. reference, or knowledge of those skilled in the art, for interpolating positional differences to produce successive digital data sets of tooth arrangements, *prima facie* obviousness of the dependent claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of dependent claims be withdrawn and the claim be allowed.

Hence, Shiota/Lockhart/Johnson/Hartman and Tackbary, singly or in combination, cannot render claim 4 obvious. Withdrawal of the Section 103 rejection is respectfully requested.

III. CLAIM 13 IS PATENTABLE UNDER SECTION 103(A) OVER SHIOTA/LOCKHART/ JOHNSON/HARTMAN AND OFFICIAL NOTICE.

Claim 13 was rejected under Section 103(a) as unpatentable over Shiota/Lockhart/ Johnson/Hartman and Official Notice. The Final Office Action noted that Shiota does not expressly disclose that the payment method is one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. The Office Action took Official Notice of both the concept and benefits of making payment online by one or more of the old and well-known methods such as credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon for the obvious reasons of convenience to both the customers and merchants and closing the purchase or sale transaction.

Appellant notes that the references fail to teach or suggest all the claim limitations of claim 1 which claim 13 depends from. In particular, the "receiving a singlecard order specifying a plurality of recipients and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient" and "for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set" are not reasonably taught or suggested in the cited art reference, as discussed above.

Moreover, Appellant notes that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the references with the Official Notice so as to arrive at receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence; for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; distributing the printed cards having the recipients' user-uploaded images to

their respective associated recipients; and charging one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon.

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Shiota et al. reference, or knowledge of those skilled in the art, for interpolating positional differences to produce successive digital data sets of tooth arrangements, *prima facie* obviousness of the dependent claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of dependent claims be withdrawn and the claim be allowed.

Hence, Shiota/Lockhart/Johnson/Hartman and Official Notice, singly or in combination, cannot render claim 13 obvious. Withdrawal of the Section 103 rejection is respectfully requested.

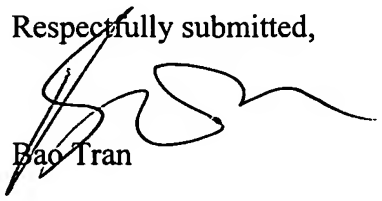
CONCLUSION

Appellant believes that the above discussion is fully responsive to all grounds of rejection set for the in the Final Office Action.

Authorization to charge Deposit Account 501861 is granted.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



Bao Tran

Reg. 37,955

APPENDIX A

1. A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence;

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.

2. The method of claim 1, wherein the card is one or more of a greeting card, a post card, and a playing card.

3. The method of claim 1, wherein the images in a first recipient's image set differ from the images in a second recipient's image set.

4. The method of claim 1, wherein print parameters of a first recipient's cards differ from printing parameters of a second recipient's cards and wherein the print parameters include one or more of print size, number of copies, print finish, and/or a textual message for the printed cards.

5. The method of claim 1, wherein the images are uploaded by a user from a digital camera.

6. The method of claim 1, wherein the images are uploaded by a user to a printing service.

7. The method of claim 1, wherein receiving, printing and distributing is dispersed among two or more different entities.

8. The method of claim 1 wherein the steps of receiving, printing and distributing is performed by a single entity.

9. The method of claim 1, wherein receiving a card order is performed by an enterprise providing a web front-end.

10. The method of claim 1, further comprising, prior to printing, dividing the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient.

11. The method of claim 1, wherein the card order comprises a single transaction sequence terminated by an order icon.

12. The method of claim 11, wherein the single transaction sequence is terminated by a click of a "card order" button.

13. The method of claim 1, wherein the card order further comprises charging to one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon.

14. A card distribution system comprising:

a front-end computer sub-system for receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient, such images being directly uploaded by a user to the front-end computer sub-system, wherein the single card order is completed in a single transaction sequence;

a printing sub-system for printing at least one card having at least one uploaded image in each recipient's image set; and

a distribution sub-system for distributing the printed cards to their respective associated recipients.

15. The card distribution system of claim 14 wherein the cards are one or more of a greeting card, a post card, and a playing card.

16. A computer-implemented method of ordering cards for a plurality of recipients, the method comprising:

receiving at a host system a single card order from a client system, the card order corresponding to a single transaction sequence and specifying a plurality of recipients and, associated with each specified recipient, a set of one or more images directly uploaded by a user, wherein the single card order is completed in a single transaction sequence.

17. A computer-implemented method of creating and distributing personalized social and business print communications to one or more recipients specified by a user, comprising:

uploading image data directly from the user specifying an appearance of the print communications;

obtaining message data from the user specifying message content to be included in the print communications;

obtaining address information from the user specifying names and addresses of the one or more recipients in a single transaction sequence;

producing the print communications incorporating the uploaded image data and the message data; and

distributing the print communications to the one or more recipients in accordance with instructions provided by the user.

18. The method of claim 17, wherein the images are uploaded by a user from a digital camera.

19. The method of claim 17, wherein the images are uploaded by a user to a printing service.

20. The method of claim 1, wherein the images are uploaded by a user from a data storage device.

21. A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a single card order from an orderer, such order specifying a plurality of recipients where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more images directly uploaded by the orderer associated with that recipient, wherein the single card order is completed in a single transaction sequence;

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.